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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 0054-0285PUS1	
	Application Number 10/829,295-Conf. #7220	Filed April 22, 2004
	First Named Inventor Hiroshi INOUE et al.	
	Art Unit 2625	Examiner J. R. Beckley

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
     Note: No more than five (5) pages may be provided.

I am the

☐ applicant /inventor.

☐ assignee of record of the entire interest.
     See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
     is enclosed. (Form PTO/SB/96)

[x] attorney or agent of record.
     Registration number   29,680

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     Registration number if acting under 37 CFR 1.34. _____

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          December 3, 2008
               Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of   1   forms are submitted.

<u>**REQUEST FOR A PRE-APPEAL BRIEF CONFERENCE**</u>

DATE: **December 3, 2008**

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed concurrently with a Notice of Appeal.

The review is being requested for the reasons set forth on the attached five (5) Sheets.

ARGUMENTS

The pending rejection exhibits clear factual and legal errors with respect to the cited reference. The specific errors relied upon in this Pre-Appeal Brief Request for Review include the lack of a *prima facia* basis for rejecting claims 1, 2, 6 and 8-11 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Watanabe et al. (U.S. 6,877,031 B2)("Watanabe") and for rejecting claims 3, 5, 7, 12, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Watanabe further in view of Yamamoto et al. (U.S. 7,228,339 B2)("Yamamoto"). Watanabe and/or Yamamoto, alone or in combination, simply fail to teach each and every element of independent claims 1 and 13.

    A.   Watanabe Fails to Anticipate Independent Claim 1

Applicants respectfully submit that Watanabe fails to teach or suggest the claimed "code conversion means", "code transmission means", and the "image data returning means" as recited in claim 1.

Watanabe merely discloses a network photograph system that stores images and allows a user 1 to select a number of images from the stored images to be distributed to a number of users. User 1 may register with the site, obtaining a user ID and password, and will be allowed access to upload images to view and distribute images corresponding to their user ID and password. Images can be electronically mailed to a destination address wherein a thumbnail size picture is enclosed or a clickable URL is included in the mail. If the receiver of the electronic mail wishes

to purchase any of the images they may do so by first registering with the site and obtaining a user ID and password. Then, the receiving user may select any of the images registered with their account and have them sent to a laboratory for printing.

The present invention teaches a printing service system and a printing service program in which a user who is unaccustomed to machine operations may print an image with ease (page 2, line 22). The printing service system includes *a code conversion means* for *converting the ID and the password into a code* storing information on the ID and the password and a *code transmission means* for *transmitting the obtained code* to the address by the destination input means (page 3, line 21 – page 4, line 15). (*Emphasis added.*) Further when the print terminal decodes the code to the ID and the password and transmits the ID and the password, performing authentication using the ID and the password, if a positive result is obtained the image data is read corresponding to the ID from the image data accumulation means and returns the image data to the prints terminal so that the user can print the image (page 3, line 21 – page 4, line 15). Under this structure, the user never has to remember their ID and password, they can simply use an encrypted code that is generated by the printing service system (page 4, lines 9- 15).

Watanabe is distinguished from the claimed invention in that nowhere does Watanabe teach or suggest *a code conversion means*, *a code transmission means*, and *a print terminal or an image data returning means* that *decodes* the encrypted code as recited in claim 1.

Watanabe discloses that when user 1 wants to access the network photograph system for viewing and uploading stored images, a WWW application server 15 requests the user 1 to input a user ID and a user password. Then, the provided user ID and password are compared with already registered user ID and password stored in a *user information database* for verification. (*Col. 7, lines 28-32.*)

The Examiner relies on the "*information database*" as disclosing the claimed "*code conversion means*" for converting the user ID and the password into a code storing information on the ID and the password. The Examiner states, "ID and password, which is associated with various kinds of information, *is understood as code of a computer* which is stored in a database and storage." (*See page 3, last paragraph and page 13, last paragraph of the Final Office Action.*) It is respectfully submitted that the Examiner is misinterpreting the "information

database" of Watanabe. The information database of Watanabe simply *stores* the ID and password of user 1 for later comparison with the same ID and password provided by user 1. *Nowhere does Watanabe teach or suggest that the information database coverts the ID and password of user 1 into a code. Emphasis added.*

In the Advisory Action, the Examiner now points to col. 1, lines 14-34, col. 3, lines 9-12, col. 6, lines 14-65, and col. 7, lines 5-67 as disclosing the claimed *code conversion means, code transmission means,* and *a print terminal or an image data returning means* that *decodes* the encrypted code as recited in claim 1.

Upon careful review of the above-identified sections of Watanabe, Applicants find no teaching or suggestion of a code conversion means that converts ID and password into a code or a code transmission means that transmits the code or a print terminal or an image data returning means that decodes the encrypted code. In col. 1, lines 14-34, Watanabe discloses that if image data is needed to be sent via email, binary data must be converted into text data and the recipient of the email must use conventional techniques to convert the text data into binary data. Further, col. 3, lines 9-12 simply discloses that the "mail transmitting means" is a function to transmit, to a network, a text file comprising a comment and an image, with information showing a title and the destination address as a mail header. Applicants find no teaching of converting ID and password information into a code and transmitting such code to a recipient of the image data.

Also, col. 6, lines 14-65 and col. 7, lines 5-67 of Watanabe is silent on any code conversion means that converts ID and password into a code or a code transmission means that transmits the code or a print terminal or an image data returning means that decodes the encrypted code.

As demonstrated above, the user of the claimed invention never has to remember their ID and password, he/she can simply *use an encrypted code* that is generated by the printing service system. Conversely, user 1 of Watanabe *always has to provide the exact ID and password that is already stored in the information database.* For example, if user 1 of Watanabe provides *a code*, instead of the actual ID and password, as input data requested by the WWW application server 15, user 1 will never be allowed to access the network photograph system since the *WWW application server 15 could not compare the code with the stored ID and password of user 1.*

As demonstrated above, the WWW application server 15 only compares the provided ID and password of user 1 with the stored ID and password of user 1 from the information database. If the ID and password of user 1 is converted into a code, the information database will not recognize such code with the stored ID and password. Thus, user 1 of Watanabe will be denied any access to the network photograph system.

The Examiner's mere allegation that ID and password associated with various kinds of information can be understood as code of a computer is totally erroneous. Even if, *assuming arguendo*, the ID and password is understood as a code of a computer, as demonstrated above in great detail, the ***WWW application server 15 could not compare such computer code with the stored ID and password of user 1***.

Therefore, for at least these reasons, it is respectfully submitted that Watanabe fails to teach "a code conversion means for converting the ID and the password into a code storing information on the ID and the password" as recited in claim 1. In addition, since Watanabe fails to teach "a code conversion means", it is submitted that Watanabe ***cannot*** teach "a code transmission means for transmitting the obtained code to the address inputted by the destination input means" as recited in claim 1. At best, Watanabe may only teach "an ID and password transmission means", ***not*** a code transmission means, for comparing stored ID and password of a user. Further, Watanabe fails to teach "an image data returning means for, when the print terminal decodes the code to the ID and the password and transmits the ID and the password, performing authentication using the ID and the password and, if a positive authentication result is obtained, reading the image data corresponding to the ID from the image data accumulation means and returning the read image data to the print terminal" as recited in claim 1. Neither the WWW application server 15 nor the information database can be properly interpreted as a ***decoder*** for decoding an encoded ID and password. As demonstrated above, if the ID and password of user 1 is transmitted as a code, neither of the WWW application server 15 and the information database would recognize such code. Accordingly, user 1 would be denied access to the network photograph system.

Accordingly, Applicants respectfully assert that Watanabe fails to anticipate Applicants' claimed invention for at least the reasons set forth above with regards to independent claim 1.

Applicants submit that claims 2, 6 and 8-11 are allowable at least by virtue of their dependency, either directly or indirectly, on claim 1.

B.   With regards to independent claim 13, The Examiner relies on Watanabe as disclosing: "*converting* by the server *the ID and the password into a code* having an information on the ID and the password; *transmitting the code* by the server to the address inputted in the address input step; and *decoding* by the print terminal *the code* so as to return it into the ID and the password and transmit the ID and the password to the server" (*Emphasis added*). As above, and for the specific reason raised against claim 13, Watanabe fails to render claim 13 obvious under § 103(a) for at least the same reasons as applied above under §102.

In an attempt to provide what is lacking in Watanabe, the Examiner has applied Yamamoto. As understood, Yamamoto discusses a storage output system wherein the user inputs a password and ID to obtain stored information. (Figure 1) With most passwords and IDs sent over the internet, it is desirable to use an encryption method such as SSL as taught in Yamamoto. Yamamoto fails to at least disclose forming a code from a password and ID. In fact, as shown in Figure 1, the user must still enter their password and ID. Encryption as described in Yamamoto is only used to prevent hackers or others on the internet from receiving this private information. Accordingly, Applicants submit that claim 13 is allowable and accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Dependent claims 2-12 are at least allowable by virtue of their dependence on allowable independent claim 1.

Reserve right to appeal other errors

While Applicants believe the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. In addition, Applicants believe that the rejection of other claims not identified above is also based on one or more Office errors. Applicants will address such issues on appeal should the appeal of this case proceed after the Office's consideration of this paper.